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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,429	09/15/1999	JOHN S. HENDRICKS	5815	7434

7590

02/20/2002

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EXAMINER

GRANT, CHRISTOPHER C

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 02/20/2002

2

Please find below and/or attached an Office communication concerning this application or proceeding.



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EXAMINER

GRANT, CHRISTOPHER C

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Office Action Summary

Application No.

09/396,429

Applicant(s)

Hendricks et al.

Examiner

Christopher Grant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 and/or 17 of U.S. Patent No. 5,990,927. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are different definitions or descriptions of the same subject matter, varying in breadth. For example, note the following relationship between application claim 1 and patented claim 17 (inclusive of the language of patented independent claim 12):

a) the claimed "*A hardware upgrade for a terminal*" (lines 1-2) of application claim 1 corresponds to the "*An upgraded set top converter for use in a cable television...*" (lines 1-6) of patented claim 12;

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b) the claimed “*an interface to the terminal*” (line 5) of application claim 1 corresponds to the “*an expansion card interface means..*” (lines 7-8) of patented claim 12; and

c) the claimed “*a modem connected to the interface*” (line 6) of application claim 1 corresponds to “*a connection means....whereby telephone signals are received..*” (lines 7-9) of patented claim 17.

It would have been obvious to one of ordinary skill in the art to readily recognize that the conflicting claims are different definitions or descriptions of the same subject matter, varying in breadth.

The limitations of application claims 2-3 and 10-13 are obvious technical features that are found in the everyday settop terminal for receiving, processing and connecting signals and hardware devices.

The limitations of application claims 4-9 correspond to the “telephone signal including the text and other data” recited in patented claim 17 because the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth.

Alternatively, the limitations of application claims 1-13 correspond to the limitations of patented claim 8 or the limitations are obvious technical features for the same reasons described above.

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As for another example, note the following relationship between application claim 24 and patented claim 17 (inclusive of the language of patented independent claim 12):

a) the claimed “*A system comprising*” (line 1) of application claim 24 corresponds to the “*An upgraded set top converter for use in a cable television delivery system*” (lines 1-6) of patented claim 12;

b) the claimed “*...a television program delivery system...*” (line 2) of application claim 24 corresponds to the “*...in a cable television delivery system*” (line 2) of patented claim 12;

c) the claimed “*an interface to the terminal*” (line 8) of application claim 24 corresponds to the “*an expansion card interface means..*” (lines 7-8) of patented claim 12; and

d) the claimed “*a modem connected to the interface*” (line 9) of application claim 24 corresponds to “*a connection means....whereby telephone signals are received..*” (lines 7-9) of patented claim 17.

Application claim 24 recites “a receiver adapted to receive at least some of the television program signals” and patented claim 17 does not specifically recite a receiver. Nevertheless all cable television set-top terminals contain a receiver (e.g. a tuner, antenna, demodulator) for receiving and processing television signals transmitted from a central facility.

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Therefore, it would have been obvious to one of ordinary skill in the art to readily recognize that items (a-d) described immediately above with regards to the conflicting claims are different definitions or descriptions of the same subject matter, varying in breadth.

Moreover, it would have been obvious to one of ordinary skill in the art to readily recognize that all settop terminals contain a receiver for receiving television program signals.

The limitation of application claim 25 corresponds to the "program delivery system " recited in patented claim 17 because the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth.

The limitation of application claims 26-28 are obvious if not necessary systems that are required for the transmission of television signals from a cable television or satellite station.

The limitation of application claim 29 is an obvious if not necessary device that is required at the receiver-end for receiving high definition signals transmitted from a cable television or satellite television station.

Claim 14 is rejected for the same reasons as described above for claim 24.

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The limitations of application claims 15-17 correspond to the limitations recited in patented claim 17 because the conflicting claims are different definitions or descriptions of the same subject matter varying in breadth.

The limitation of application claim 18 is an obvious if not necessary device that is required at the receiver-end for receiving high definition signals transmitted from a cable television or satellite television station.

The limitations of application claims 19-23 are obvious technical features that are found in the everyday settop terminal for receiving, processing and connecting signals and hardware devices.

Claim Objections

3. Claim 51 is objected to because of the following informalities: Claim 51 is improperly dependent on claim 52. Claim 52 is not a preceding claim as required under MPEP 608.01 (n).

A dependent claim must refer to a preceding claim which, in turn, refers to another preceding claim. See MPEP § 608.01(n).

Appropriate correction is required.

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Claim Rejections - 35 USC § 112

4. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 57 recites the limitation "the information concerning programs" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-3, 11, 13-16 and 19-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Graczyk et al. (Graczyk).

Considering claims 1, 14 and 24-25, Graczyk discloses a system comprising:

- a) a television program delivery system (broadcast or cable TV) (col. 5, lines 62-68);
- b) a terminal (24) comprising a receiver (col. 4, line 63-66) adapted to receive at least some of the television program signals;
- c) a hardware upgrade (12) comprising:

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(c1) an interface (16450 interface) (col. 7, lines 9-18); and

(c2) a modem (104) connected to the interface.

Claim 2 is met by processor (RC224) (figure 2)

Claim 3 is met by memory (108,110)

Claim 11 is met by the connector in figure 41.

Claim 15 is met by the display of the data or fax received via the modem that indicates that the upgrade is in use. See the entire reference including but not limited to col. 5, lines 1-14.

Claim 16 is met by the expansion slot in figure 45 that accepts the interface connector as indicated in figure 41.

Claim 19 is met by the additional cards, connectors or modules illustrated in figures 42, 43 and 44. Note also that figure 45 illustrates the capability of accepting additional cards or boards or modules.

Claims 13 and 20-21 are met by the terminal (24) which operates with (ISA) interfaces, COM1, COM2 and COM3 ports (col. 6, line 62 - col. 7, line 8) and SCSI connectors (see the entire reference including but not limited to col. 22, lines 52-68) which are serial or daisy chain configurations.

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Claim 22 is met by the simultaneous uses of one or more of the hardware upgrades as discussed in col. 5, lines 3-14.

Claim 23 is met by one of audio program reception hardware (18-figure 1 or 530-figure 43 or 510-figure 44).

7. Claims 30-42, 45-52, 55-56 and 58-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Palazzi, III et al. (Palazzi).

Considering claim 30, Palazzi discloses a television terminal comprising:

- a) a television program receiver (11);
- b) a modem (4);
- c) an output (9, 10, 15) connected to the receiver (11) and modem (4), wherein the output accepts television program signals from the receiver and data signals from the modem.

Claim 31 is met by television (15).

Claim 32 is met by connector port (10).

Claim 33 is met by microprocessor (5).

Claim 34 is met by memory discussed at col. 6, lines 18-45, 53-54, col. 7, lines 62-68 and col. 9, lines 20-40.

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Claims 35-39 are met by the interactive services/on-line databases provided by the host databases that are external to the television program delivery system discussed throughout the entire reference including but not limited to column 1, line 5 - column 4, line 45, column 5, lines 63-66 and column 9, line 60 - column. 10, line 35.

Claim 40 is met by the online database containing travel information, stock quotation and other data as discussed throughout the reference including but not limited to col. 1, lines 15-23, col. 3, lines 25-60 and col. 9, line 60 - col. 10, line 35.

Claim 41 is met by the HDTV capability disclosed in col. 6, lines 55-64.

As for claim 42, Palazzi, discloses a method comprising:

- a) receiving a television program (11) (col. 7, lines 54-61);
- b) receiving subscriber input (col. 5, lines 63-66 & col. 8, line 23 - col. 9, line 20);
- c) communicating through a modem comprising:
 - (c1) transmitting data based on subscriber input via (keyboard 12) (col. 7, line 62 - col. 9, line 20)
 - (c2) receiving data (col. 5, lines 63-66 and col. 9, lines 2-20); and

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d) displaying the television program and/or information based on the received data (see the entire reference including but not limited to col. 3, line 64 - col. 4, line 16, col. 7, lines 54-61 and col. 9, lines 4-29).

Claims 45-49 are met by the interactive services/on-line databases provided by the host databases that are external to the television program delivery system discussed throughout the entire reference including but not limited to column 1, line 5 - column 4, line 45, column 5, lines 63-66 and column 9, line 60 - column. 10, line 35.

Claim 50 is met by the online database containing travel information, stock quotation and other data as discussed throughout the reference including but not limited to col. 1, lines 15-23, col. 3, lines 25-60 and col. 9, line 60 - col. 10, line 35.

Claims 51-52 are met by the various memory discussed at col. 6, lines 18-45, 53-54, col. 7, lines 62-68 and col. 9, lines 20-40.

Claim 55 is met by the processing of stored digital data discussed throughout the reference including but not limited col. 6, lines 18-64 and col. 9, lines 20-40.

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Claim 56 is met by stored data concerning banking services (economics) and any other local national or regional information services (reference) discussed throughout the entire reference including but not limited to col. 9, line 60 - col. 10, line 4.

Claim 58 is met by remote input from keypad (16), keyboard (12) or the keyboard connected to the CPU via a wireless link as illustrated in figure 1.

Claim 59 is met by is met by the generated menu discussed at col. 9, lines 13-40 and col. 10, lines 16-18.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graczyk and Palazzi.

Considering claims 4-9, Graczyk discloses monitoring financial news via a financial news network in col. 5, lines 3-14. He fails to specifically disclose that the modem is capable of communicating with interactive service, the interactive service is outside the television program

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delivery system, the interactive service is selected from the group consisting of home shopping, airline reservations, news, financial information, advertisement, home banking and interactive text, communicating with an on-line database and the on-line database is outside the television program delivery system as recited in the claims.

Palazzi discloses a modem that is capable of communicating with several interactive services and/or on-line databases wherein the interactive services/on-line databases are outside the television network. This provides a terminal with the ability to efficiently communicate with various networks, interactive services and databases. See the entire reference including but not limited to column 1, line 5 - column 4, line 45, column 5, lines 63-66 and column 9, line 60 - column. 10, line 35.

It would have been obvious to one of ordinary skill in the art to modify Graczyk's system (if necessary) to include a modem capable of communicating with interactive service, the interactive service is outside the television program delivery system, the interactive service is selected from the group consisting of home shopping, airline reservations, news, financial information, advertisement, home banking and interactive text, communicating with an on-line database and the on-line database is outside the television program delivery system, as taught by Palazzi, for the advantage of providing a terminal with the ability to efficiently communicate with various networks, services and databases.

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10. Claims 10, 12, 17-18 and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graczyk.

Considering claims 10 and 12, Graczyk discloses various types of connectors in columns 12-36 and figures 41-48. However, he fails to specifically disclose that the interface is a four-wire connector and a multi-pin connector ranging from DB9 and DB25 as recited in the claims.

The examiner takes Official Notice that it is notoriously well known in the art to utilize four-wire connectors and multi-pin connectors ranging from DB9-DB25 to connect one device to another. These are readily available low cost connectors used in television and/or computer terminals and they provide a convenient way to connect and dis-connect devices and electronic products.

It would have been obvious to one of ordinary skill in the art to modify Graczyk's system to include a four-wire connector and a multi-pin connector ranging from DB9 and DB25 because these are readily available low cost connectors that provide a convenient way to connect and dis-connect devices.

As for claims 17-18, Graczyk discloses an electronic visual communication system and more particularly a multi-purpose computerized television system (col. 1, lines 5-10). He also disclosed that various modifications and alternative embodiments are apparent to a person skill in the art. (col. 36, lines 14-22). However, he fails to specifically disclose that the terminal is a set top terminal or an HDTV terminal as recited in the claims.

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The examiner takes Official Notice that set top terminals and HDTV terminals are notoriously old and well known in the art for receiving regular and high resolution television signals.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Graczyk's multi-purpose television system to include the terminal to be a set top terminal or an HDTV terminal because these well known and readily available terminals for receiving regular and high resolution television signals.

As for claims 26-29, Graczyk discloses receiving television signals from broadcast and cable television stations (col. 5, lines 61-68). However, he fails to specifically disclose an operations center, one or more headends and a satellite broadcasting system as recited in the claims.

The examiner takes Official Notice that an operations center (a central facility to a headend or master headend), one or more headends and a satellite broadcasting system are notoriously old and well known communication stations that broadcast television signals to subscribers. At these stations television programs are received, processed and prepared for transmission to subscribers.

Therefore, it would have been obvious to one of ordinary skill in the art to modify Graczyk's system (if necessary) to include an operations center, one or more headends and a

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satellite broadcast system because these are typical places where television signals are received processed and prepared for transmission to subscribers.

11. Claims 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzi and Sprague et al. (Sprague).

Considering claims 53 and 54, Palazzi discloses that various types of memory devices may be used (col. 6, lines 34-38). However, he fails to specifically disclose that the memory device is a CD-ROM as recited in the claims.

However, Sprague discloses that CD-ROMs are conventional and commercially available memory devices for storing data or information. See col. 2, lines 6-39 and col. 19, lines 1-16.

It would have been obvious to one of ordinary skill in the art to modify Palazzi's system to include the memory device to be a CD-ROM, as taught by Sprague, for the typical advantage of using a conventional and commercially available device to store data.

12. Claims 43-44 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzi and Vogel.

Considering claims 43-44, Palazzi discloses receiving various types of data but he fails to specifically disclose that the data is information concerning television program and that the information is selected from a group consisting of quizzes, facts, geographical information and product information as recited in the claims.

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Vogel discloses data/information concerning television programs (program schedule). Program schedule information includes facts and description of television programs. See the entire reference including but not limited to col. 3, lines 45-65 and col. 8, lines 36-46.

It would have been obvious to one of ordinary skill in the art to modify Palazzi's system to include information concerning a television program and that the information is to be selected from a group consisting of at least quizzes, facts, geographical information and product information, as taught by Vogel, for the typical advantage of receiving program schedule information about programs to inform viewers about current and future television programs.

Claim 57 is met by the combined systems of Palazzi and Vogel, because Vogel discloses monitoring for reception of the program schedule information and then retrieving digital data after the reception of the program schedule information in col. 3, line 2 - col. 4, line 5.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bowen et al., Bacon et al., Moura et al. each disclose hardware upgrades for terminals. Yurt et al., De Bey and Remillard each disclose a terminal with a modem.

14. **Any response to this action should be mailed to:**

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Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry and for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306 0377.

Christopher Grant
Christopher Grant
Primary Examiner
November 29, 2001